

Application No.: 10/561,877

5

Docket No.: 61506(71699)

REMARKS

Claims 1 - 23 are pending in the application. Claims 1, 18 and 24 have been amended. Claim 5 has been cancelled. Claims 15 and 16 have been cancelled as being drawn to non-elected subject matter. No New claims have been added. No new matter has been added by virtue of the amendments and claims, support being found throughout the specification and claims as originally filed.

Any cancellation of the claims should in no way be construed as acquiescence to any of the Examiner's rejections and was done solely to expedite the prosecution of the application. Applicant reserves the right to pursue the claims as originally filed in this or a separate application(s).

Rejection of Claims 1 – 4, 6 – 14 and 17 Under 35 USC 112, Second Paragraph

The Examiner has rejected claims 1 – 4, 6 – 14 and 17 under 35 USC 112, second paragraph for alleged indefiniteness. Applicants respectfully traverse the rejection.

The Examiner argues that "claim 1 is indefinite because of the phrase 'corresponding to'. The type and degree of correspondence can not be determined therefore the metes and bounds of the claimed invention cannot be determined." (Office Action, p.3).

While in no way acquiescing to the validity of the Examiner's rejection, and solely in the interest of expediting prosecution, Applicants have amended claim 1 and respectfully request that the rejection be withdrawn.

Rejection of Claims 18 - 24 Under 35 USC 102(b)

The Examiner has rejected claims 18 -24 under 35 USC 102(b) as being anticipated by Goggins et al. (WO 02/068694; the '694 reference herein). Applicants respectfully traverse the rejection.

Claim 18, as amended, recites a method for detecting a methylated CpG-containing SPARC nucleic acid molecule, wherein the methylated SPARC nucleic acid molecule comprises the nucleic acid sequence set forth in SEQ ID NO: 1, the method

BQS2 739875.1

Application No.: 10/561,877

6

Docket No.: 61506(71699)

comprising: contacting a nucleic acid-containing specimen with bisulfite to modify unmethylated cytosine to uracil; contacting the SPARC nucleic acid molecule with oligonucleotide primers that discriminate between methylated and unmethylated CpGs; and detecting the methylated CpGs in the nucleic acid. The method of claim 24, as amended, comprises detecting a SPARC nucleic acid molecule, wherein the methylated SPARC nucleic acid molecule comprises the nucleic acid sequence set forth in SEQ ID NO: 1.

To anticipate a claim, each and every element of the claim must be found in a single reference. This is discussed in the Manual of Patent Examining Procedure § 2131:

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the . . . claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an ipsissimis verbis test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

The '694 reference does not teach or suggest all the limitations of the instant claims. In particular, the '694 reference does not teach or suggest

Nowhere does the '694 reference, expressly or inherently, teach or describe a method comprising the detection of a methylated SPARC nucleic acid molecule or a variant thereof in a sample from a subject, wherein the methylated SPARC nucleic acid molecule **comprises the nucleic acid sequence set forth in SEQ ID NO: 1** (Figure 6). Again, Applicants direct the Examiner's attention to Table 1 of the '694 reference, which clearly sets forth the identified differentially methylated sequences.

Based on the foregoing; Applicants submit that the claims are not anticipated by '694 et al.

Accordingly, Applicants respectfully request withdrawal of the rejection and allowance of the claims.

BOS2 739875.1

Application No.: 10/561,877

7

Docket No.: 61506(71699)

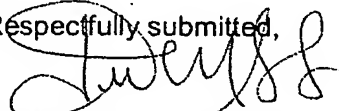
CONCLUSION

Applicants believe that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

Dated: June 3, 2009

Respectfully submitted,



Jonathan M. Sparks, PhD
Registration No.: 53,624
EDWARDS ANGELL PALMER & DODGE
LLP
P.O. Box 55874
Boston, Massachusetts 02205
617-517-5595
Attorneys/Agents For Applicant

638259v1_BOS2

BOS2 739875.1